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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,219	12/18/2000	Alejandro Wiechers	10001310-1	3213

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HEWLETT-PACKARD COMPANY
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EXAMINER

CHEN, TE Y

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,219

Applicant(s)

WIECHERS, ALEJANDRO

Examiner

Susan Y. Chen

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7-9,11,12,14 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7-9,11,12,14 and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This office action is in response to the amendment filed on 11/16/2005.

Claims 1, 3-4, 7-9, 11-12, 14 and 21-26 are pending for examination, claims 1, 3-4, 7-9, 11-12, 14 have been amended; claims 2, 5-6, 10, 13, 15-20 have been canceled; and claims 21-26 have been newly added.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-4, 7-8, 21-22 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Seder et al. (U.S. Patent No. 6,522,770).

As to claim 1, Seder discloses an electronic document coding system, comprising:

a) a reference repository [e.g., the database 18, Fig. 1 and associated texts], wherein, the reference repository receives the electronic file and its characteristic information [e.g., an Watermark at col. 2, lines 40-46 or meta-data at col. 2, lines 60-65 or the embedded Hyperlink of a Web page at col. 4, lines 15-20] from the communication network [e.g., the XYZ network at col. 45-48] and stores the characteristic information in a memory [e.g., col. 3, lines 6-9, 32-34; col. 6, lines 29-30].

b) an indexing unit linked with the reference repository for assigning an identification code to the electronic file based on the associated characteristic data [e.g., col. 2, lines 39-65; the database 18 at col. 5, lines 5-14; the watermark payload technique at col. 6, lines 21-45] wherein, the marking including assigning an existing inventory code [e.g., the UID code at col. 1, lines 38-50; col. 7, lines 15-19] and compiles the identification code for the electronic files from the classification code and the inventory code via steganographic encoding algorithm [e.g., col. 2, lines 47- col. 3, lines 2; col. 7, lines 15-19].

c) an editing unit linked with the reference repository and the indexing unit, wherein, the editing unit insert the identification code to the electronic file [e.g., col. 4, lines 8-50].

As to claim 3, except all the limitations recited in claim 1, Seder further discloses that the system communicates via Internet [e.g., col. 3, lines 39-45].

As to claim 4, except all the limitations recited in claim 1, Seder further discloses that the system electronic files comprise published material [e.g., paper documents at col. 1, line 12].

As to claim 7, except all the limitations recited in claim 1, Seder further discloses that the system indexing unit assigns the identification code to the electronic file with respect to the characteristic information [e.g., the watermark payload technique at col. 6, lines 21-45].

As to claim 8, except all the limitations recited in claim 7, Seder further discloses that the system stores the identification code with respect the characteristic information [e.g., col. 3, line 6-38].

As to claim 21, this claim recites the same features as claim 1 in method with broader scope, hence is rejected for the same reason.

As to claim 22, except all the limitations recited in claim 21, Seder further discloses that the electronic file represents a publication [e.g., publication objects at col. 4, lines 15-18], and the characteristic information includes author, the number of pages of the publication, etc. [e.g., col. 1, lines 35-37].

As to claim 25, this claim recites the same feature as claim 22 in form of system, hence is rejected for the same reason.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 11-12, 14, 23-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seder et al. (U.S. Patent No. 6,522,770) in view of Van Huben et al. (U.S. Patent No. 6,327,594).

As to claim 9, Seder discloses an electronic document coding system, comprising:

a) a reference repository [e.g., the database 18, Fig. 1 and associated texts], wherein, the reference repository receives the electronic file and its characteristic information [e.g., an Watermark at col. 2, lines 40-46 or meta-data at col. 2, lines 60-65 or the embedded Hyperlink of a Web page at col. 4, lines 15-20] from the communication network including Internet [e.g., the XYZ network at col. 45-48] and stores the characteristic information in a memory [e.g., col. 3, lines 6-9, 32-34; col. 6,

lines 29-30]. Seder further discloses that the electronic file comprises published material [e.g., a printable page at col. 4, lines 55-63; any printable object at col. 6, lines 17-20].

b) an indexing unit linked with the reference repository for assigning an identification code to the electronic file based on the associated characteristic data [e.g., col. 2, lines 39-65; the database 18 at col. 5, lines 5-14; the watermark payload technique at col. 6, lines 21-45] and software procedures [e.g., the steganographic encoding algorithm at col. 1, line 38-40; the database management modules at col. 3, line 14-20] wherein, the index marking including using an existing inventory code [e.g., the UID code at col. 1, lines 38-50; col. 7, lines 15-19] and compiles the identification code for the electronic files from the classification code and the inventory code via steganographic encoding algorithm [e.g., col. 2, lines 47- col. 3, lines 2; col. 7, lines 15-19].

c) an editing unit linked with the reference repository and the indexing unit, wherein, the editing unit insert the identification code to the electronic file [e.g., col. 4, lines 8-50].

Seder did not specifically disclose that the software encoding procedures are library-specific.

However, Van Huben et al. (hereinafter referred as Van Huben) discloses the software procedures are library-specific [e.g., Abstract, lines 3 –28; col. 5, line 30 – col. 6, line 30].

Seder and Van Huben are both in the same field of endeavor to code internet objects via scalable software programs, therefore, with the teachings of Seder and Van Huben in front of him/her, an ordinary skilled artisan at the time the invention was made would be motivated to apply Van Huben library specific-procedures to modify Seder's system, for the purpose to construct more centralized library specific programs for coding the electronic files of the system such that the combined system will integrate the various types of coding programs to facilitate the centralized control for coding, scaling and tracing of a specific library operation as suggested by Van Huben [Van Huben: col. 5, lines 9-20].

As to claim 11, except all the limitations recited in claim 9, the combined system of Seder and Van Huben further discloses that the editing unit formats the identification code as authorized by the library [e.g., Van Huben: the units: 91, 93 processing, Fig. 9].

As to claim 12, except all the limitations recited in claim 9, the combined system of Seder and Van Huben further discloses a review unit linked with the indexing unit for facilitating the reviewing of formatted electronic file [e.g. Seder: the printer driver monitor at col. 4, lines 32-40].

As to claim 14, except all the limitations recited in claim 12, the combined system of Seder and Van Huben further discloses that the review unit dispatches the formatted

Art Unit: 2161

electronic file to form a book on demand client machine [e.g., Seder: col. 4, lines 41 – 53].

As to claim 23, this claim recites the same features as claim 9 in form of method with broader scope, hence is rejected for the same reason.

As to claim 24, the combined system of Seder and Van Huben further discloses that the electronic file represents a publication [e.g., Seder: publication objects at col. 4, lines 15-18], and the characteristic information includes author, the number of pages of the publication, etc. [e.g., Seder: col. 1, lines 35-37]

As to claim 26, this claim recites the same features as claim 24 in form of system, hence, is rejected for the same reason.

Response to Arguments

Applicant's arguments with respect to claims 1, 3-4, 7-9, 11-12 and 14-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Gustman (U.S. Patent No. 5,832,499) which discloses a digital library system to management the digital assets.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y. Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen
Examiner
Art Unit 2161

February 16, 2006



UYEN LE
PRIMARY EXAMINER